

REMARKS

Summary of the Interview Conducted on March 5, 2009

Attorney Janice Rice for the Applicants spoke with Examiner John Mabry, Ph.D. requesting clarification of the scope of the claims that the Office regards as enabled. The Examiner and Attorney agreed to discuss the issue further at a second interview to include Attorney Rice, Examiner Mabry, and Examiner Desai.

Summary of the Interview Conducted on March 12, 2009

Attorney Rice spoke with Examiner Mabry and Examiner Desai on March 12, 2009. Applicants agreed to modify the scope of R¹⁵ as well as delete or replace the terms “heterocyclyl” and “heterocyclylalkyl.” The Office stated it would get back to the Applicants with respect to their arguments regarding the term “monocyclic heteroalicyclic.”

Amendment of the Claims

Claims 1, 9, 12 and 13 are amended to correct typographical and punctuation errors.

In Claim 1, the term “heterocyclalkyl” is deleted from the optional substituents on R⁷ of -A-R⁷ to more particularly point out and distinctly claim what the Applicants regard as their invention.

Claim 1 is amended to delete the terms “heterocyclyl” and “aryl” from the optional substituents on R⁷ of -A-R⁷ and to add the term “a monocyclic heteroalicyclic” in order to more particularly point out and distinctly claim what the Applicants regard as their invention. Support for replacing “heterocyclyl” with “a monocyclic heteroalicyclic” can be found in the definitions of “heterocyclyl” and “heteroalicyclic” in paragraphs [0071] and [0072], respectively, as well as compounds 82, 83, and 85 in Table 1.

In Claims 1, 9, and 12, the R⁴ and R⁵ groups are amended to replace R⁷ with “alkyl,” “1,3-dioxo-isindol-2-ylethyl,” and “aryl.” Support for these changes can be found in the original listing of groups in R⁷ as well as in compounds 28, 51, 64, 67, 74, 76, 77, 95, 96, 97, 101, 102, 103, 104, 105, 106, 108, 110, 111, 113, 115, 117 and 118 in Table 1.

In Claim 1, R⁶, R⁷, and R¹⁵ are amended to more particularly point out and distinctly claim what the Applicants regard as their invention.

In Claim 9, the optional substituents on the R¹² C₁₋₈alkyl are amended to more particularly point out and distinctly claim what the Applicants regard as their invention. The term “heterocyclyl,” is replaced with the term “a monocyclic heteroalicyclic.” Support for replacing the term “heterocyclyl” with “monocyclic heteroalicyclic” can be found in the definitions in paragraphs [0071] and [0072], respectively, as well as compounds 82, 83, and 85 in Table 1.

In Claim 9 and 12, R⁷ and R¹⁵ are amended to more particularly point out and distinctly claim what the Applicants regard as their invention.

Claims 12 and 13 are amended to add the word “monocyclic” before the term “heteroalicyclic” in R¹³. Support for this can be found in the definitions of “heterocyclyl” and “heteroalicyclic” in paragraphs [0071] and [0072], respectively, as well as compounds 82, 83, and 85 in Table 1.

Claim 13 is amended to more particularly point out and distinctly claim what the Applicants regard as their invention with respect to R⁶, R⁷, and the optional substituents on the phenyl formed when R⁴ and R⁵ are combined, .

Claim 40 is amended to add compound 28, and Claim 41 is amended to delete compound 28. This change is made to correct an error in dependency. Claim 40 is amended to delete Compound 1 which is not within the scope of the present restriction group. Claim 41 is amended to delete compound 14 which is not within the scope of the present restriction group. Claim 42 is amended to add compound 42, and Claim 43 is amended to delete compound 42. This change is made to correct an error in dependency.

Specification Objections

The Applicants thank the Examiner for withdrawal of this objection.

35 U.S.C. § 103 Rejection

The Applicants thank the Examiner for withdrawing this rejection.

35 U.S.C. § 112 Rejection

Claims 1-9, 12-17, and 39-48 are rejected as not enabled for “R¹³ being all claimed heteroalicyclic compounds, R⁴ and R⁵ being all fused cyclic rings claimed and R¹⁰ being all substituents claimed” (page 2, Final Rejection). In particular, the Office states that R¹⁵ is enabled for only “halogen, unsubstituted alkoxy and unsubstituted alkyl”

(page 3, Final Rejection). Applicants respectfully request reconsideration of this rejection for the following reasons.

In the Final Rejection, the Office maintained the rejection of the scope of R¹⁰. The Applicants respectfully direct the Office's attention to their response on October 23, 2008 to the first Office Action (July 29, 2008) where they pointed to specific examples in the Specification of R¹⁰ groups which the Office does not regard as enabled. Further, in response to the Office's concern over how to make starting materials for the other R¹⁰ groups, Applicants provided references which detail how to make various, representative R¹⁰ groups. The Applicants submit that they have enabled a person of ordinary skill in the art to make and use the full scope of R¹⁰ without undue experimentation.

In the Final Rejection, the Office maintained the enablement rejection of the full scope of the term "heteroalicyclic" for R¹³. To support the rejection, the office crafted a ring which would fall within the scope of the term "heteroalicyclic" but for which it could not find a preparation in the art. Without regard to whether the particular ring the Examiner created is inoperative or not, the Applicants submit that presence of inoperative embodiments does not necessarily render a claim nonenabled (M.P.E.P. § 2164.08(b)). The test is "whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art." (M.P.E.P. § 2164.08(b)) The Applicants submit that a person of ordinary skill in the art would be able to determine readily whether a particular ring could be made or not.

Applicants respectfully disagree with the Office regarding enablement. However, in order to expedite examination, the Applicants have amended the scope of the term "heteroalicyclic" in R¹³ to "monocyclic heteroalicyclic." In addition, the terms "heterocyclyl" and "heterocyclylalkyl" have been deleted or replaced, and the groups R⁶, R⁷, and R¹⁵ have been amended. In light of the above amendments and arguments, the Applicants believe that the enablement rejection has been overcome and respectfully request its withdrawal.

SUMMARY


In view of the foregoing, the Applicants believe the Application is in condition for allowance and respectfully request entry of the amendments and reconsideration of the

objections and rejections for the above given reasons.

It is not believed that a fee is due with the submission of this response. However, should any fees be required by the USPTO in order to process this submission and the papers attached, the Commissioner is hereby authorized to charge the necessary fees to Deposit Account Number 50-1108.

Respectfully submitted,

March 13, 2009
Date


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